

No. 20662

United States
COURT OF APPEALS
For the Ninth Circuit

JEDDELOH BROTHERS SWEED MILLS, INC.,
a Corporation, OTTO JEDDELOH, FRED JEDDELOH,
Appellants,
v.

COE MANUFACTURING COMPANY,
a Corporation,
Appellee,
and

COE MANUFACTURING COMPANY,
a Corporation,
Appellee and Cross-Appellant,
v.

JEDDELOH BROTHERS SWEED MILLS, INC.,
a Corporation, OTTO JEDDELOH, FRED JEDDELOH,
Appellants and Cross-Appellees.

*Appeal from the United States District Court for the
District of Oregon*

Civil No. 9702 (JUDGE SOLOMON)

RESPONSE TO PETITION FOR REHEARING

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RESPONSE TO PETITION FOR REHEARING

1. The Court correctly understood that Parker was obvious in view of the prior art.

Plaintiff attacks the Court's opinion by trying to make it appear that the opinion turned on whether Streeter discloses means for maintaining roll-stack alignment (now referred to in the Petition, p. 2, as means to "accommodate variations in height at the source"). In order to support this argument plaintiff has improperly ripped selected excerpts from the opinion.*

The whole thrust of the opinion is that even assuming all doubtful matters in Parker's favor, the patent did not meet the strict test of obviousness under Sec. 103 and the controlling cases.

The first error in plaintiff's argument is that it incorrectly reads into claims 3, 5, 7 and 17 some means to "accommodate variations in height at the source." There is no such limitation in those claims.

In any event, regardless of whether or not such

* The quotation from the Streeter patent (Petition, p. 1, three lines from bottom) should read "... a stationary frame (not 'feed) section 14" [II.449, lines 7-8 (not Tr. IV)]. Petition page 2 first quotation from the Court's opinion, the word "critical" was omitted after "only." Also on page 2 the second quotation from the Court's opinion was not as indicated a complete sentence but plaintiff omitted the following clause "... such as shown by the Cross and Campbell patents at the infeed end."

These misquotations, while perhaps not as serious as others by plaintiff (Reply Br. Apls. & Cross Aplees., pp. 16-17), are nevertheless always favorable to its argument.

reading in is permissible, Parker is still obvious in view of the prior art. Cross and Campbell, each of whom shows a vertically adjustable elevator for supporting stacked sheet material, clearly disclose such means to "accommodate variations in height at the source." The Court will also recall that plaintiff, in order to assert *infringement*, had to take the position throughout the proceedings that the Parker claims cover a separate elevator in front of the Jeddelloh machine (Ans. Br. Cross Aplt. & Aplee., pp. 29, 30; PX 54, II.353).*

Secondly, plaintiff's statement that the Court did not understand Streeter is wrong. The Court was completely correct in stating that Streeter has everything called for in the asserted claims except pinch rolls, and that these are shown in Cross or Campbell (Opg. Br. Aplts. & Cross Aplees., pp. 28, 29). Obviously if unit A** in Streeter is replaced by the pinch roll feed mechanism of Cross or Campbell, the machine will work precisely the way Parker does.

* What is sauce for the goose is sauce for the gander so that in considering the question of *validity* of Parker's claims, Streeter's unit A is just as much a "vertically movable feed means" as Jeddelloh's separate elevator.

** Streeter's unit A (Fig. 1) has a "vertically movable feed means" (this is all that is called for in claim 17) in rolls 4 which are intermittently vertically moved by toggle links 6 actuated by arm 7 to lift sheets from belts 2 [II.448 (lines 75, 76, 91-96), 449 (lines 101-106)]. Conveyor mechanism B comprises a frame 16 which is vertically moved under an automatic control mechanism to deliver sheets to the decks of dryer C.

2. The correct criteria was applied in determining obviousness of Parker.

This Court correctly applied the test of obviousness discussed in *Graham v. John Deere*, 383 U.S. 1, 15 L. Ed. 2d 545. In *Graham* the Court expressly followed its prior decisions* and said that there was ". . . no change in the general strictness with which the overall test is to be applied.", and "The standard has remained invariable in this Court." (15 L. Ed. 2d at 557).

3. A. & P. and the decisions of this Court have held that for a combination of old mechanical elements to be patentable the elements must perform an additional or different function in combination than out of it.

Because the Parker patent has never been able to meet the foregoing test, plaintiff now argues that it does not exist, or that if it does, it is unconstitutional (Petition, pp. 3, 4). A. & P. did not originate this test but merely reiterated the longstanding case law as expressed in *Lincoln Engineering Co. v. Stewart-Warner*, 1938, 303 U.S. 545 and gave renewed vitality to the test (340 U.S. at 151, 152).

In a long line of cases, the most recent expression of which is *Santa Anita Mfg. Corp. v. Lugash*, No. 20,267, decided December 6, 1966, other panels of this Court have followed the same test and come up with the same answer as that of the present panel. Similar to the situation in *Lugash*, the district court

* *Hotchkiss v. Greenwood*, 11 How. 248, and *Great A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147.

here never applied that test to Parker. Neither plaintiff nor the district court have ever suggested any new operation, function or result of the Parker patent except to feed *veneer* rather than some other sheet material. Such use of the equipment obviously is not patentable invention.*

Lugash also holds (p. 7 slip sheet) that ". . . the addition of another element of prior art cannot make the device patentable unless it then performs a new or surprising function." The addition of the Cross or Campbell feed to Streeter falls precisely within this proscription.

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464, relied on by plaintiff stands squarely for the proposition that:

"The application of an old process to a new and closely analogous subject matter, plainly indicated by the prior art as an appropriate subject of the process, is not invention." (at 473)

Plaintiff's reliance on *Walt Disney Productions v. Niles Communications Center*, 7th Cir., 1966, 151 USPQ 528 is misplaced because, in that case at 531 ". . . both defendants' expert and the District Court apparently based their opinions [of obviousness] as of the time of trial." Because hindsight had been used the wrong test was employed. With respect to the court's statement that "unusual and surprising result as a controlling factor has gone with the flash of

* *Griffith Rubber Mills v. Hoffar*, 9 Cir. 1963, 313 F.2d 1, and cases cited in Reply Br. Aplts. & Cross Aplees., p. 11.

creative genius," see Judge Castle's dissenting opinion in which he flatly contradicts the majority by reference to the controlling language in *U. S. v. Adams*, 383 U.S. 39 and the *A. & P.* case. Also see the later decided 7th Circuit case of *Strzalkowski v. Beltone Electronics Corp.*, Dec. 6, 1966, 151 USPQ 675 which held at 677 "The mere relocation of old elements, producing no new or unexpected result is not invention."

4. The Court resolved every secondary consideration with respect to indicia of non-obviousness in plaintiff's favor, and still found that Parker did not amount to patentable invention.

Even if the Parker patent satisfied a long felt need and was a commercial success, neither of which it was (Reply Br. Aplts. & Cross Aplees., pp. 5, 6; Opg. Br. Aplts. & Cross Aplees., p. 8), this Court correctly held that those factors were at best make-weights in close cases of patentability, and that where the alleged patentable improvement is obvious and invention clearly lacking, they are of no moment.*

Respectfully submitted,

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